

Remarks

Currently pending in the application are Claims 1-16, wherein Claims 1-16 are rejected under 35 U.S.C. § 112 first and second paragraph, wherein Claims 2 and 3 are further rejected under 35 U.S.C. § 112, second paragraph, wherein Claims 1, 3-8, 15, and 16 are rejected on the grounds of non-statutory obviousness-type double patenting, and wherein Claims 1-16 are rejected under 35 U.S.C. § 103(a).

In view of the following remarks, Applicant respectfully requests reconsideration by the Examiner, and advancement of the application to allowance.

1. **Objection to the Specification**

The Examiner requests that Applicants amend the specification to reflect the current status of the parent application 09/954,311. Applicants agree that subsequent to the filing of the sibling application, the parent application 09/954,311 was abandoned. Accordingly, Applicants have amended page 1, lines 5-7 to indicate that Application Serial No. 09/954,311 has gone abandoned.

The Examiner requests that Applicants amend page 7, line 20 of the specification to show the required bonds disclosed in the formula. Applicants respectfully assert that the bonds were inadvertently omitted, thank the Examiner for his attention to detail, and have made the amendment without prejudice.

2. **Rejection Under 35 U.S.C. § 112, first and second paragraphs**

Claims 1-16 stand rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. Applicants respectfully assert that the specification clearly states that “[t]he poly(dimethylsiloxane)-polyoxyethylene surfactant is preferably

essentially free of oxyalkylene units derived from alkylene oxides **other than ethylene oxide.**” Specification page 9, lines 14-16 (emphasis added). Moreover, Applicants note that Comparative Examples 1 and 2 illustrate an embodiment wherein the surfactant contributes 0.0011 moles of PO per 100g of the polymer derived from the reaction system. Applicants respectfully assert that a system wherein the surfactant contributes 0.0011 moles of PO per 100g of the polymer derived from the reaction system is not essentially free of oxyalkylene units derived from alkylene oxides other than ethylene oxide. Accordingly, Applicants assert that “the specification contain[s] guidelines and examples that [should be] considered sufficient to enable a person of ordinary skill in the art” to understand the claimed invention.

Claims 2 and 3 are further rejected under 35 U.S.C. § 112, second paragraph as the Examiner asserts that the term “about” with respect to the number of repeating molecules and atoms renders the claims indefinite. Applicants thank the Examiner for presenting them the opportunity to clarify their claim language. Accordingly, and without prejudice, Applicants have amended claims 2 and 3 to delete the terms “about” as indicated above.

Applicants therefore respectfully request that the rejection and objection to Claims 1-16 under 35 U.S.C. § 112, first and second paragraphs be withdrawn.

3. Filing of Terminal Disclaimer

Claims 1, 3-8, 15, and 16 stand rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1 and 9 of U.S. Patent. No. 6,887,911. However, the Office Action suggests that such a rejection may be overcome by the filing of an oath or declaration under 37 C.F.R. § 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior invention under 35 U.S.C. § 104, together with a terminal disclaimer in accordance with 37

C.F.R. § 1.321(c). Thus, in the interest of furthering prosecution, Applicants respectfully file a terminal disclaimer, and the necessary oaths, along with this Response to Office Action.

Applicants submit that the terminal disclaimer filed herein was executed by Nicole Graham, an attorney of record.

Applicants therefore respectfully request that the rejection to Claims 1, 3-8, 15, and 16 on the ground of non-statutory obviousness-type double patenting be withdrawn.

4. Rejection Under 35 U.S.C. § 103(a)

Claims 1-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,389,696 to Dempsey et al. ('696) in view of U.S. Patent No. 5,500,176 to Parks et al. ('176) or U.S. Patent Nos. 5,993,528 and 5,670,553 to Mackey ('528 and '552) and further in view of U.S. Patent Nos. 5,916,939 and 5,852,107 to Gillis et al. ('939 and '107).

The Office Action asserts that '696 discloses Applicant's claimed invention except that '696 fails to disclose applicants' component c) ii), fatty acid. Applicants agree that '696 fails to disclose applicants' component c) ii), fatty acid; however, Applicants also assert that '696 fails to disclose a poly(dimethylsiloxane)-polyoxyethylene surfactant, which contributes more than **0.006 moles** of EO per 100g of the polymer derived from the reaction system. Instead, Applicants assert that the surfactant Example 1 of '696 **would contribute at most 0.0053 moles** of EO per 100g of the polymer derived from the reaction system. See the attached Rule 1.132 Declaration of Trent Shidaker.

Without wishing to be bound by the theory, Applicants assert that the fatty acid of its claimed invention reacts with the NCO group of the isocyanate to form an amide. The amide in combination with the fatty ester forms a synergy that results in an improved number of releases. Such a result—as pointed out by the Examiner—was seen in '107 and '109. Surprisingly,

however, Applicants found that such a synergy was greatly enhanced in the presence of a poly(dimethylsiloxane)-polyoxyethylene surfactant, which is essentially free of oxyalkylene units derived from alkylene oxides other than ethylene oxide, and is present in the reaction system in an amount such that the poly(dimethylsiloxane)-polyoxyethylene surfactant contributes more than 0.006 moles of EO per 100g of the polymer derived from the reaction system.

Applicants respectfully assert that “[w]hen applying 35 U.S.C. 103, the following tenets of patent law must be adhered to: ... (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) The reference must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention ...”. See M.P.E.P. § 2141 (II). Moreover, “[t]o establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success....” See M.P.E.P. § 2142.

Moreover, Applicants assert that “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” M.P.E.P. § 2143.01 (III). Accordingly, Applicants respectfully assert that nothing in ‘696, ‘176, ‘528, ‘552, ‘939, and ‘107 suggests or motivates one of ordinary skill in the art to add a fatty acid to the system of ‘696 to arrive at Applicants’ claimed invention, wherein the surfactant contributes at least 0.006 moles of EO per 100g of the polymer derived from the reaction system. Such a combination(s) of references is not permitted, as they could only be made with the benefit of impermissible hindsight. See M.P.E.P. § 2141 (II).

Applicants therefore respectfully request that the rejection to Claims 1-16 under 35 U.S.C. § 103(a) be withdrawn.

5. Request For Extension of Time

Pursuant to 37 C.F.R. § 1.136(a), Applicants hereby request a one (1) month extension of time to file a response to the Office Action Mailed September 29, 2006. This request extends the original due date of December 29, 2006 one (1) month to January 29, 2006. Applicant has enclosed the \$120 fee for a large entity.

Conclusion

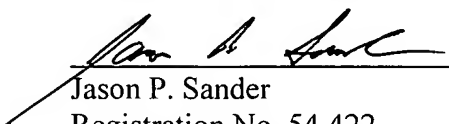
In view of the foregoing remarks, Applicant respectfully submits that the application is now in condition for allowance, and respectfully requests issuance of a Notice of Allowance directed towards the pending claims.

Applicant has submitted herewith a check in the amount of \$120 for payment of the one-month extension of time. Should any other fee be due in connection with the filing of this document, the Commissioner for Patents is hereby authorized to deduct said fee from Deposit Account No. 07-0153.

Please date stamp and return the enclosed postcard to acknowledge receipt of this material.

1/25/07
Date

Respectfully submitted,



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